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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PERRIN, JOSEPH L

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,570

Applicant(s)

SCHWARTZ, SHARON

Examiner

Joseph L. Perrin, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, drawn to an apparatus, classified in class 134, subclass 198.
 - II. Claims 10-15, drawn to a method of cleaning, classified in class 134, subclass 34.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another process such as a method of coating or painting.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.
6. During a telephone conversation with Applicant's representative, Mr. John C. Smith on 20 January 2004 a provisional election was made with traverse to prosecute

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the invention of Group I, claims 1-9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

7. Figure 7 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

8. It appears Figure 7 is a variant of the paint sprayer of Figure 1 (disclosed as prior art), which are the objects to be cleaned via the claimed invention. Therefore, clarification and correction of Figure 7 as "prior art" is required.

Specification

9. The disclosure is objected to because of the following informalities:

On page 11, line 17, the term "paint" should be --pointed--;

On page 13, beginning of second paragraph, the phrase "close of" should be --close up--;

appropriate correction is required.

Claim Objections

10. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Re claim 6, applicant's limitation of flexible extension tubes appears to be the same limitation as that in the claim of which it depends (claim 5), the limitation being "means to align" each nozzle with a holding device, which described in the specification (for instance, page 7, top paragraph & page 11, last paragraph) as being such flexible extension tubes. Accordingly, as best understood from the specification, claim 6 does not further limit claim 5. Clarification and correction are required.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 2-3, 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-3, 5-6 and 8-9 are considered vague and indefinite. In claims 2, 5, 8 and 9, applicant's claimed limitation of "means to align (adjustably align)" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. Applicant also separately claims at least one

flexible extension tube. However, to the contrary, applicant's "means to align" limitation is described as being a flexible extension tube, as described on page 7, top paragraph & page 11, last paragraph of the specification. It is unclear what applicant intends.

As best understood from the original disclosure, applicant's "means to align" is construed as the flexible extension means and the claims will be examined accordingly. However, clarification and correction are still required.

Similarly, claim 7 is considered vague and indefinite. Applicant has failed to define the meets and bounds of patent protection sought since applicant has not disclosed any corresponding structure or equivalents thereof, as required by 35 U.S.C. 112, sixth paragraph.

Specifically, applicant claims the limitation of "means to attach" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, 35 U.S.C. 112, sixth paragraph, clearly states that "such claim shall be construed to cover the corresponding structure, material or acts described in the specification and equivalents thereof." Since applicant has not disclosed such structure or equivalents thereof covered by the claimed "means to attach", it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

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Thus, as best understood from the original disclosure as filed, applicant's "means to attach" limitation is construed as being "is/are attached", as described on page 15, first paragraph (Figure 10) of the original disclosure, and the claims will be examined accordingly. However, clarification and correction are still required.

Further regarding claims 5-9, which depend from independent "kit" claim 4, these claims are considered indefinite since these dependent claims are directed to an "apparatus". Is applicant claiming a kit or an apparatus in the dependent claims? As best understood from the original disclosure, the claims are directed to the kit of claim 4, and the claims will be examined accordingly. However, correction of the preamble in claims 5-9 to correlate to claim 4 is still required.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,937,875 by Nygren.

Re claims 1-3, Nygren discloses an apparatus having a basin 110, a plurality of supply nozzles (nozzles 74 & 76), a plurality of holding devices (clips

98 connected to removable rack 20), a plurality of cleaning nozzles attached to a plurality of flexible extension tubes (which lead to the supply nozzles), the flexible tubes being equivalent to means to adjustably align (cleaning nozzles being end adapters 82/84 located on flexible tubes 78 which are aligned with the holding device via connection to the object to be held) (see entire reference of Nygren, specifically Figure 2; col. 2, lines 30-46; col. 3, lines 10-25).

It is noted that how the flexible extension tubes are adjustably aligned is considered intended use and given little patentable weight in apparatus claims. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original) Moreover, Applicant's "whereby" clause in claim 1 is considered intended use since the clause recites the operation of the apparatus and fails to further structurally limit the claimed apparatus. It has been held that the functional "whereby" statement does not define any structure and accordingly can not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

Re independent claim 4, Applicant claims a "kit". It is noted that the recitation of "for attachment to cleaning machines" in independent claim 4 has not been given significant patentable weight because the recitation occurs in the preamble. A preamble is generally accorded little patentable weight where it

merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). It is further noted that Merriam-Webster (<http://www.merriamwebster.com>) defines of a kit as being "a group of persons or things", and thus, claims 4-5 and 7-9 will be examined accordingly.

Re claims 4-5 & 8-9, Nygren discloses a group of structures including a plurality of holding devices (clips 98 connected to removable rack 20), a plurality of cleaning nozzles attached to a plurality of flexible extension tubes which are fed from solvent supply (manifold 60), the flexible extension tubes being equivalent to means to adjustably align (cleaning nozzles being end adapters 82/84 located on flexible tubes 78 which are aligned with the holding device via connection to the object to be held) (see entire reference of Nygren, specifically Figure 2; col. 2, lines 30-46; col. 3, lines 10-25).

As previously noted, the recitations of how the flexible extension tubes are adjustably aligned is considered intended use and given little patentable weight in apparatus claims.

Re claim 7, Nygren discloses a plurality of brackets (see support rack 20 having four vertical members 50 and horizontal members 52/54/52, Figures 2 & 3) which, in view of the Figures 2 & 3, inherently must attach to the solvent

supply 60 and, as a result, extension tubes 78 with cleaning nozzles due to the interwoven relationship between solvent supply manifold 60 and support rack 20 including vertical members 50, horizontal members 52/54 and ring members 46/48.

Accordingly, recitation of Nygren reads on applicant's claimed invention.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 5,220,933 to Albers, which discloses a paint sprayer cleaning apparatus including a basin, holders and spray nozzles (this reference is substantially cumulative to at least the independent claims already rejected above).

US 4,784,170 to Romanelli *et al.*, which discloses a cleaning kit including a solvent supply and nozzles.

US 4,025,363 to De Santis, which discloses a paint sprayer cleaning apparatus including a basin, a holder and spray nozzles with flexible extension tubes (this reference is substantially cumulative to at least independent claim 1 already rejected above).

US 3,771,539 to De Santis, which discloses a paint sprayer cleaning apparatus including a basin, a holder and spray nozzles with flexible extension

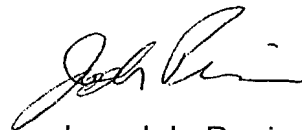
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tubes (this reference is substantially cumulative to at least independent claim 1 already rejected above).

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph L. Perrin, Ph.D. whose telephone number is (571)272-1305. The examiner can normally be reached on M-F 7:00-4:30, except alternate Fridays.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571)272-1302. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

18. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-1700.



Joseph L. Perrin, Ph.D.
Examiner
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jlp